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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,824	02/28/2006	Hans-Peter Mettler	LP2012	5378
217 7590 05/03/2007 FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006			EXAMINER YOUNG, SHAWQUA	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 05/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/569,824

Applicant(s)

METTLER, HANS-PETER

Examiner

Shawquia Young

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 7-11, 13 and 15-21 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1, 6 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/7/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-22 are currently pending in the instant application.

### **I. *Priority***

The instant application is a 371 of PCT/EP04/09690, filed on August 31, 2004 and claims benefit of Foreign Application EPO 03077734.6, filed on September 1, 2003.

### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 7, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### **III. *Restriction/Election***

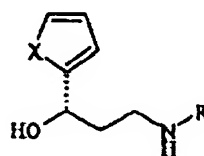
#### **A. *Election: Applicant's Response***

Applicants' election with traverse of Group I in the reply filed on March 27, 2007 is acknowledged. The traversal is on the ground(s) that: (1) the Examiner stated in the Restriction Requirement that a precise listing of inventive groups cannot be made and (2) the statement "the claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compound defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art" as being a mere assertion that is not supported by facts and factual analysis in the record.

All of the Applicants' arguments have been considered but have not been found

persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Applicants argue that the statement "the claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compound defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art" as being a mere assertion that is not supported by facts and factual analysis in the record. However, the Examiner points out that the reference is used to solely show that the special technical feature in applicants' claims does not show a contribution over the prior art. The special technical feature of the applicants' claims should link all of the claims together and the common link is the compounds that



contain the following core excluding the variables . The special technical feature is known in the prior art and therefore the applicants' claims lack unity of invention.

The Examiner has decided to combine Group I and II and examine claims 1-11 and 13-21, drawn to a process for the preparation of compounds of formula (I) wherein: X is O or S and R represents hydrogen or C<sub>1-6</sub> alkyl, C<sub>3-8</sub> cycloalkyl, aryl or aralkyl.

Subject matter not encompassed by elected Group I and II are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

#### **IV. Objections**

##### *Claim Objections*

Claims 1, 6 and 14 are objected to because of the following informalities: claim 1 has a misspelled term "C<sub>1-4</sub> alkyl" in variable R. Claims 6 and 14 have the misspelled term "fiene". Appropriate correction is required.

##### ***Specification***

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

The disclosure is objected to because of the following informalities: a missing period at the end of the specification on page 12.

Appropriate correction is required.

***Oath/Declaration***

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in EPO on September 1, 2003. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

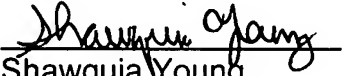
**V. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

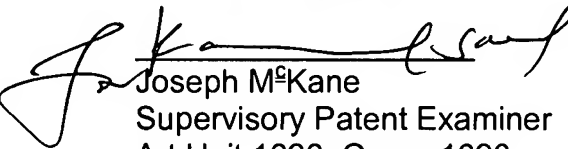
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>e</sup>Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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